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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,283	09/15/2000	Daniel Meilhon	6219-0012	9760
21967	7590	06/06/2005	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			CHEN, VIVIAN	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/601,283

Applicant(s)

MEILHON, DANIEL

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 31-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/18/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The rejections under 35 U.S.C. 103(a) based on WINTER (US 4,705,707) has been withdrawn in view of Applicant's amendments and arguments filed 3/18/2005.

3. Claims 18-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIHARU ET AL (US 5,912,070) or EUROPEAN PATENT APPLICATION 0 800 914 (hereinafter EP '914).

MIHARU ET AL discloses a symmetrical five layer film having a ABCBA structure, excellent fold retention, and suitable for twist wrap packaging applications, wherein layer "C" is an ethylene/cycloolefin copolymer and layer "A" is a polyester, wherein the polyester comprises units derived from dicarboxylic acids (e.g., terephthalic acid combined with other dicarboxylic acids such as isophthalic acid or naphthalene-2,6-dicarboxylic acid) and diols (e.g., ethylene glycol combined with other glycols such as propylene glycol or cyclohexanedimethanol). The

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film has a typical overall thickness of 5-250 microns, with layer "C" typically comprising 5-150 microns and layer "A" typically comprising 1-50 microns as recited in claims 18-24, 30.

Polyester layers "A" optionally contain lubricants and/or antistatic agents as recited in claim 28.

(MIHARU ET AL, line 40-50, col. 3; line 54, col. 3 to line 30, col. 5; line 53-55, col. 17; line 64, col. 17 to line 10, col. 18; line 3-30, col. 18) (EP '914, see corresponding portions)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the symmetrical film structures of MIHARU ET AL and EP '914 in order to obtain a durable, moisture-proof twist wrapping materials. One of ordinary skill in the art would have applied conventional metallic or print layers to the film (claim 29) in order to obtain specific decorative effects and/or convey package information. One of ordinary skill in the art would reasonably believe that the disclosed films are capable of substantially retaining a shape (i.e., substantially retaining a fold, crease, etc.) under certain conditions; therefore the Examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald et al.*, 205 USPQ 594. Since the films in MIHARU ET AL can be non-oriented (orientation being optional) and since polyesters are typically amorphous upon initial (co)extrusion (prior to orientation), the Examiner has reason to believe that MIHARU ET AL discloses films in which the polyester layers are in amorphous form (claims 19-20).

Response to Arguments

4. Applicant's arguments filed 3/18/2005 have been fully considered but they are not persuasive.

(A) Applicant argues that MIHARU ET AL fails to disclose the recited symmetrical film structure. However, the reference explicitly discloses a five layer symmetrical film structure ABCBA wherein layers A are formed of terephthalic acid and ethylene glycol-based copolyesters containing up to 20 mol% diol comonomers containing 3 or more carbons (equivalent to the recited copolyesters) and layer C is an ethylene/cycloolefin copolymer (equivalent to the recited polyolefin). Therefore, MIHARU ET AL teaches either explicitly or implicitly both the claimed symmetrical film structure and the recited layer compositions.

(B) Applicant argues that MIHARU ET AL fails to disclose the claimed invention because the prior art films contain five layers. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a film containing only three layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The present claims only require two outer layers and a middle (i.e., core) layer, but the present claim language does not preclude the presence of additional layers as long as the requirement of symmetrical construction and composition is met.

(C) Applicant argues that MIHARU ET AL fails to disclose amorphous or very low crystallinity PETG surface layers. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., amorphous or PETG outer layers) are not recited in the majority of the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to the claims explicitly requiring outer layers containing amorphous polyester (claims 19-20), since MIHARU ET AL discloses copolyester compositions which are substantially similar to those recited in the present claims (in regard to both the comonomer(s) used and the amount of said comonomers), the Examiner has reason to believe that at least some of the disclosed copolyesters are similar in crystallinity (i.e., are amorphous). Applicant has not provided probative evidence of criticality or unexpected results from the use of amorphous polyesters.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 27, 2005



Vivian Chen
Primary Examiner
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